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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,795	05/02/2001	John C. Goodwin III	9371	4913

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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,795

Applicant(s)

GOODWIN ET AL

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 8-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination (“RCE”) under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application on February 8, 2005. This application was under a final rejection (the First Final Office Action, mailed November 4, 2004) and is therefore eligible for continued examination under 37 C.F.R. §1.114. Because the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality in the previous First Final Office Action has been withdrawn pursuant to 37 C.F.R. §1.114.

Acknowledgements

2. In accordance with the RCE noted above, Applicant’s after final amendment filed January 19, 2005 has now been entered. Accordingly, claims 1, 3-5, and 8-21 remain pending.

3. All references in this Office Action to the capitalized versions of “Applicants” refers specifically the Applicants of record. References to lower case versions of “applicant” or “applicants” refers to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” in this Office Action refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally.

4. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *e.g. In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

6. A timely filed terminal disclaimer in compliance with 37 C.F.R. §1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. §1.130(b).

7. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. §3.73(b).

8. Claims 1 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22 of Adamac et. al. (U.S. 6,243,690 B1)(“Adamac ‘690”). Although the conflicting claims are not identical, they are not patentably distinct from each other because Adamac ‘690 discloses an EPL witch stores a promotional message and promotional data file (the file storing the promotional message). It is the Examiner’s position that it would have been obvious to reference the promotional messages by a message number stored in *e.g.* integer form in a relational database to reduce memory usage.

Claim Rejections - 35 USC §112 2nd Paragraph

9. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 3-5, 8-15, and 21 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 1, "host computer" is indefinite because it is unclear if it is a previously recited host computer. The Examiner suggests 'a host computer.'

Claim Rejections - 35 USC §102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 3-5, and 8-21 are rejected under 35 U.S.C. §102(b) as being anticipated by Goodwin III (U.S. 5,854,474)("Goodwin '474"). Goodwin '474 discloses the claimed invention including a EPL 10 having a separate promotional file (storing the promotional message); a PLU

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(storing the price of the item); reading the promotional message from the promotional data file and sending it to the ES (inherent in any promotional message system).

13. Claims 1, 3-5, and 8-21 are rejected under 35 U.S.C. §102(b) as being anticipated by Goodwin III (U.S. 5,907,143) ("Goodwin '143"). Goodwin '143 discloses the claimed invention including an ES (the text segment within 14 in Figure 2); a plurality of EPLs 14, a PLU file 36, a common host computer 12; a promotional data file (the text message string as part of 28); a promotional identification number (the "promotional indicator" within data file 28); an EPL/ES data file 28.

Claim Rejections - 35 USC §103

14. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1, 3-5, and 8-21, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Goodwin '474.¹ It is the Examiner's principle position that the claims are anticipated because it is inherent that when a computer reads an identification number (such as the keyed field in a relational database system) in EPL/ES file, type checking (inherent in programming languages) alone determines if the identification

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

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number is associated with the ES or EPL. The Examiner notes that the currently claimed system and method does not require that the ID be indicative of either a ES or EPL.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Goodwin '474 to implement the system is a relational database system. Such a modification would have allowed for the most efficient use of computational resources (*e.g.* memory).

16. Claims 1, 3-5, and 8-21 are also alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Goodwin '143. It is the Examiner's principle position that the claims are anticipated because an EPL is a form of electronic sign.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Goodwin '143 to an additional EPL as an electronic sign. Such a modification would have allowed multiple signs within the same system.

17. For due process purposes, the Examiner again confirms that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions.² First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants

² See the Office Action mailed March 18, 2004, Paragraph No. 10; the First Final Office Action mailed November 4, 2004, Paragraph No. 12.

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have also not pointed to a term or terms in a claim with which to draw in those statements³ with the required clarity, deliberateness, and precision.⁴ Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,⁵ Applicants' responses have not point out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants did not argue lexicography *was* invoked). Forth and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation to be their own lexicographer. Finally, after receiving express notice of the preceding factual findings and conclusions, Applicants' latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b). Moreover, Applicants' latest response—while fully considered by the Examiner—does not change the Examiner's conclusion that Applicants have decided not to be their own lexicographer. Therefore (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is confirmed. Accordingly, the claims continue to be interpreted with their "broadest reasonable interpretation," *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027

³ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁴ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁵ See Note 2.

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(Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.⁶

18. Under the broadest reasonable interpretation standard noted above and unless modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous Office Action. Those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary⁷) during ex parte examination.

Response to Arguments

19. Applicants' arguments filed January 19, 2004 have been fully considered but they are not persuasive.

Prior art

20. Applicants argue that "Goodwin '143 does not disclose and does not make obvious 'an EPL/ES datafile which is separate from the PLU file,' as presented in claim 1."⁸ The Examiner respectfully disagrees. See figure 1 where 28 is separate from 36. Second, the promotional data

⁶ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]"

⁷ See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) ("[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.").

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file 28 must be stored as an electronic file. Additionally, a identification number (keyed field in a relational database) is clearly stored in multiple files (promotional data file, ES file, etc).

Applicants' arguments are therefore not persuasive.

21. Applicants also argue that "Goodwin '143 does not disclose or render obvious "reading a promotional message corresponding to the promotional identification number from the promotional data file," as recited in claim 1.⁹ The Examiner respectfully disagrees. Under a relational database system, the message is a text field and is tracked, used, and implemented with a keyed field which is the promotional identification number. Clearly a relational database reads the message via the keyed field.

22. To be clear, the anticipation rejection using Goodwin '143 *is* based upon an inherency argument. MPEP §2112 clearly authorizes such a rejection. Regarding inherency, it is the Examiner position that to meet the all elements test in either anticipation or obviousness, the inherent elements—like the directly disclosed elements—must be shown by a preponderance of the evidence. *In re Epstein*, 32 F.3d 1559, 1564, 31 USPQ2d 1817, 1820 (Fed. Cir. 1994) ("Preponderance of the evidence is the standard that must be met by the PTO in making rejections." (citations and quotations omitted)).

23. To the support the Examiner's position on inherency, the Examiner finds that microcomputer database products typically are relational databases. Based upon the entire record, the Examiner finds that it is therefore more likely than not that the disclosed system in

⁸ Applicants' Remarks Filed January 19, 2004, Page 12, ~ lines 14 and 15.

⁹ Applicants' Remarks, Page 12, ~ lines 16-18.

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Goodwin '143 is implemented with a relational database system. Such systems are old and well known in the art.

24. While the Examiner understands the objects of the invention as noted in Applicants' arguments, it is the Examiner's position that such objects are not reflected in the currently pending claims.

Lexicography

25. Applicant argues that he "respectfully traverse the unnecessary and extensive legal discussion of the law governing the Applicants' right be their own lexicographer" ¹⁰ While the Examiner notes that it is clearly Applicants' right to state that such discussions are "unnecessary" and because of lexicography's tremendous impact to claim interpretation during ex parte examination, ¹¹ it is the Examiner's position that lexicography is initially always at issue in ex parte examination.

26. While Applicants also state that "much of the legal discussion is either incorrect, incomplete, or inappropriate to the present context," the Examiner notes that Applicants have failed to point out and the supposed errors in the analysis in accordance with 37 C.F.R.

§1.111(b). Such arguments are therefore not persuasive.

¹⁰ Applicants' Remarks, Page 10, ~ lines 5 and 6.

¹¹ When applicants *are* their own lexicographer and successfully redefining a claim to have a meaning other than its ordinary and accustomed meaning, the claims *must* be examined using that meaning. See MPEP §2173.05(a) and *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

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27. Moreover, all statutes, rules, MPEP citations, and legal discussions are provided for due process purposes and are designed to give applicants actual notice of the examiner's legal conclusions. The fact that Applicants deem them "unnecessary and extensive" does not relieve the Examiner of providing due process.¹² Just as examiners must provide conclusions of law, examiners are also the initial fact finders.¹³ Therefore examiners are required to provide findings of fact for both review¹⁴ and due process purposes.

28. Because Applicants have stated that such discussions on lexicography are unnecessary, and because the record is now abundantly clear that Applicants have decided not to be their own lexicographer, the Examiner will henceforth not discuss lexicography in any future office actions. To be extremely clear, it Applicants' position (and not the Examiner's) that such discussion are "unnecessary." Therefore, if Applicants make lexicographic arguments in any future amendment, argument, appeal brief, and/or other paper, the Examiner will cite this paragraph and respectfully state that such discussions have been considered unnecessary.

¹² "To be sure, an administrative agency cannot impose a penalty or forfeiture without providing notice." *In re Bogese*, 303 F.3d 1362, 1368, 64 USPQ2d 1448, 1453 (Fed. Cir. 2002).

¹³ See e.g. *Waldemar Link GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558, 559, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994) ("During the prosecution of the parent application, the patent Examiner acts as a factfinder."); and *In re Berg*, 320 F.3d 1310, 1315, 65 USPQ2d 2003, 2007 (Fed. Cir. 2003) ("As persons of scientific competence in the fields in which they work, examiners and administrative patent judges on the Board are responsible for making findings, informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art . . .").

¹⁴ See Note 7.

Conclusion

29. References considered pertinent to Applicants' disclosure are listed on form PTO-892. Unless expressly noted otherwise by the Examiner, all references listed on form PTO-892 are cited in their entirety.

30. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

32. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner again notes and thanks Applicants for their "Remarks" (beginning on page 7) traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal

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conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹⁵ the Examiner respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (571) 272-6788. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
May 2, 2005

¹⁵ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.